

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants :Koichi NAGOSHI et al.

Group Art Unit : 2173

Appl. No. : 10/663,688

Examiner : S. Muhebbullah

Filed : September 17, 2003

Confirmation No. : 3984

For : MULTIFUNCTION APPARATUS, SERVER, AND SERVER SYSTEM

REPLY BRIEF UNDER 37 C.F.R. § 41.41(a)(1)

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir :

In response to the Examiner's Answer of April 29, 2009, that was issued in response to the revised Appeal Brief filed on February 9, 2009 in which the period for response (i.e. filing a Reply Brief) was set to expire in two months (i.e. on June 29, 2009) Applicants respectfully requests entry of the present Reply Brief:

Remarks begin on page 2 of this Reply Brief:

REMARKS

In the Examiner's Answer of April 29, 2009, in section "(10) Response to Argument" the Examiner addressed and responded to a number of arguments set forth by Applicants in the Appeal Brief of February 9, 2009. Applicants submit that the Examiner's responses are inaccurate and incorrect and that accordingly Applicants' arguments are valid. Accordingly, based upon the following remarks taken together with the arguments contained in the above-noted Appeal Brief, the outstanding rejections in the present application now on appeal should all be reversed and the present application should be returned to the Examiner to be processed for allowance.

The Examiner's responses will be addressed below in the manner classified by the Examiner:

a) With respect to Applicants' argument that none of the references address the problem to which Applicants' invention is directed, the Examiner asserted that *KITADA et al.* teaches an example of one multi-function apparatus which does not include a fax and directed Applicants' attention to paragraph 23, lines 15-16. The Examiner's assertion is incorrect. The portion of *KITADA et al.* quoted by the Examiner explicitly says that the MFD "can create web pages ... and send a fax". Thus, the Examiner's position is clearly incorrect.

Further, merely because a fax server is also involved in a facsimile transmission process of *KITADA et al.* does not mean or imply that the MFD of *KITADA et al.* does not include facsimile capability. The mere fact that, at best, *KITADA et al.* acknowledges the existence of an

MFD which cannot send a facsimile does not imply that the disclosure thereof addresses the problem that the present invention addresses and solves in the manner set forth in the pending claims.

b) None of the paragraphs relied upon (i.e. cited) by the Examiner to disclose sending to the server scanned image data with predetermined information, as recited, teach this feature. In this regard, paragraphs [0033] and [0034], which deal with MFD profiles, merely indicate that the profiles include an identification of the device such as the serial number and various parameters such as computer network name, the machine location utilized to configure the exchange of information between the scan server 40 and the MFDs 10 - 30.

c) Regarding the deficiencies of *TANIMOTO* with respect to transmitting the image data by facsimile transmission, the Examiner asserts that the combination teaches this feature. However, in setting forth rejection, Applicants note that the Examiner relies on *TANIMOTO* to teach transmitting data from a multifunction facsimile server to a receiving apparatus. Applicants claim 28 recites "transmitting the image data to a receiving apparatus by facsimile transmission". However, since *TANIMOTO* does not teach facsimile transmission to a recipient at all, clearly the disclosure thereof cannot overcome the deficiency of *KITADA et al.* for which *TANIMOTO* was relied upon by the Examiner.

d) This argument apparently relates to the recitations of claim 29. However, the paragraph cited by the Examiner relates to faxing and e-mailing as well as to how "Fax Notes" are utilized. The cited paragraph contains no disclosure relevant to the recitations of claim 29.

e) The Examiner's comment, which apparently relates to claims 36 and 56 paraphrases the recitations of these claims. These claims recite that the information regarding the menu is utilized for the "multi-function apparatus" and also for "another multi-function apparatus" as each of these terms are defined in the independent claim, while the cited paragraphs relate to display screens. None of the cited paragraphs discloses the features actually recited in these claims.

f) The Examiner's assertion (with respect to claims 41 and 42) that *KITADA et al.* teaches the tracking of jobs does not address the recitations of claim 41 which requires that the information regarding the menu contain a menu item name, a job ID and job parameters. A job ID is clearly not disclosed in paragraph [0043].

g) The Examiner's assertion (with respect to claims 43, 44, 46 and 62) is based on the assumption that because the functions of the MFD of *KITADA et al.* is controlled, it follows that the specific job parameters recited in these claims are disclosed therein. This is submitted to be incorrect.

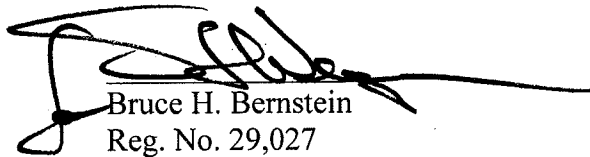
The remaining comments made by the Examiner under headings h) - l) are similarly based on the Examiner's paraphrasing and summarizing the particular recitations of the respective dependent claims. The features actually recited in the claims however, are not disclosed by either of the references (or by the combination) relied upon by the Examiner in the outstanding rejections.

CONCLUSION

In view of the above noted shortcomings of the Examiner's rejections, taken together with the Arguments set forth in the above-noted Appeal Brief, Applicants respectfully request that the Board of Appeals reverse the outstanding rejections and return the present application to the Examiner to process for allowance.

Should there be any questions or comments regarding the present paper, or this application, the undersigned can be reached at the below listed telephone number.

Respectfully Submitted,
Koichi NAGOSHI et al.



Bruce H. Bernstein
Reg. No. 29,027

June 22, 2009
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Steven Wegman
Reg. No. 31,438